

REMARKS

Claims 1-14 are pending. By this Amendment, claims 1, 6, 10 and 13 are amended merely to clarify the nature of a goals outline. Accordingly, this amendment is not considered to narrow the scope of the claims. Basis for the amendments is found in Applicants' disclosure, including on page 2, lines 13-22 which point out that the goals outline organizes the information of the document in a logical manner.

The attached Appendix contains a marked-up version of claims 1, 6, 10 and 13 per 37 CFR 1.121.

The Office Action objects to claims 10-12 because claim 10 inadvertently omitted the word "input." This objection is respectfully traversed based on the amendment to claim 10, which inserts "input" between "based on the" and "and the data".

Accordingly, Applicants respectfully request that the objection be withdrawn..

The Office Action rejects claims 1-3, 6, 7 and 10-13 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-6 and 20-22 of U.S. Patent 6,374,271. This rejection is respectfully traversed.

Applicants file herewith a Terminal Disclaimer under 37 CFR §1.321(c) which includes a provision that any patent granted on this application shall be enforceable only for and during such period that the patent is commonly owned with U.S. Patent 6,374,271.

Applicants respectfully submit that the Terminal Disclaimer overcomes this rejection. See, in this regard, MPEP §§ 804.02 and 1490.

The Office Action rejects claims 1-3, 6, 7, and 27-33 under 35 USC §103(a) as unpatentable over U.S. Patent 6,029,182 to Nehab et al. This rejection is respectfully traversed.

Claims 1, 6, 10 and 13 have been amended to clarify that the goals outline comprises organization of document information content. The Office Action asserts that Fig. 9B of

Nehab discloses a goals outline, the container 87, which includes a URL list of information content for a web page where the data for the web page can be arranged in such an order or rearranged.

However, the URL list of web pages is not a goals outline as recited. It is not an organization of document information content. It is a mere list of web page URLs, and web page URLs do not constitute document information content.

Moreover, claim 1, for example, recites linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises organization of document information content and the presentation outline comprises document appearance characteristics. Nehab does not disclose or suggest the recited linking feature.

Any linking in Nehab is of web-site content and format, and web-site content is not what Nehab discloses as organization of document information content.

Similar comments apply to claims 6, 10 and 13, which all have been recite that the document goals outline comprises organization of document information content.

The rejection is also traversed based on the lack of proper motivation to one of ordinary skill in the art to modify Nehab to include a controller coupled to a user interface and a memory that links a goals outline comprising organization of document data (which is not disclosed in Nehab for the reasons stated above) and a presentation outline.

Nehab does not need such a controller and the only suggestion for having such a controller is in Applicants' own disclosure. This motivational statement is based on improper hindsight reconstruction of Applicants' claimed invention from Applicants' disclosure.

The first requirement of proper motivation is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d

1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d at 1000, 50 USPQ2d 1614, at 1617 (Fed. Cir. 1999).

Applicants also respectfully point out that the rejection fails to demonstrate a clear and particular teaching to motivate one to modify Nehab. The alleged motivation is just an inference drawn by the Office Action from Nehab and thus is not a clear and particular teaching in Nehab. In fact, the inference in the Office Action clearly did not lead Nehab to make the asserted modification. The alleged motivation is nothing more than speculation and is actually based on Applicants' disclosure rather than Nehab's disclosure.

Moreover, the case law requires that for motivation to be proper, showing that something is feasible is not enough. Just because something may be feasible does not mean that it is desirable or that one of ordinary skill in the art would be motivated to do what is feasible. See Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580 (Fed. Cir. 2000) which points out that motivation to combine references requires a showing not just of feasibility, but also of desirability.

The only desirability of modifying Nehab to arrive at the claimed invention is found in Applicants' disclosure and it is fundamentally improper to use Applicants' disclosure against them.

Moreover, even if Nehab were modified as asserted in the Office Action, the resulting modification would not render the claimed invention obvious for the reasons stated above.

Additionally, because claims 2-5 depend from claim 1, the Office Action also fails to make out a prima facie case of obviousness of claims 2-5.

With respect to the merits of claim 2, in addition to not showing the features of claim 1 discussed above, Nehab does not display a goals outline which comprises organization of document information content on the display device and generate the goals outline based on the input that relates to the goals outline display.

With respect to the merits of claim 3, in addition to not disclosing the features recited in claims 1 and 2 discussed above, Nehab et al. does not disclose or suggest a controller generating a logical structure of the goals outline as recited. The document prototype is part of the goals outline. Nehab et al. does not disclose any goals outline document prototypes to be instantiated and selected by the input received through the user interface. While Nehab et al. has a profile manager 38, the profile manager maintains document templates that specify how to format a personal newspaper, using predefined document templates, which specifies layout information, font information, style information, colors, etc. These templates are presentation templates, not goals outlines. Accordingly, claim 3 is not rendered obvious by Nehab et al.

With respect to the merits of claims 4 and 5, claim 5 depends from claim 4 and claim 4 depends from claim 3 and recites that the memory contains a card and linking the instantiated document prototype to the card selected by the input received through the user interface. Because Nehab et al. does not recite the features of claim 3, for the reasons stated above, Nehab et al. does not anticipate or render obvious claims 4 and 5. Moreover, Nehab et al. has no disclosure of a card or any disclosure of an instantiated document prototype to link with information contained in memory. The assertion in the Office Action that a card is

merely where to store data is incorrect. Applicant's disclosure states, on page 5, lines 29-31 that the cards in the card database 106 are information elements (called points) on which the document being authored are based. Accordingly, claims 4 and 5 are neither anticipated nor rendered obvious by Nehab et al.

With respect to independent claim 6, Nehab et al. fails to anticipate or render obvious claim 6, because claim 6 recites method steps corresponding to the apparatus features of claim 1, and claim 1 is neither anticipated nor rendered obvious by Nehab et al for the reasons stated above.

With respect to claims 7, 8 and 9, which recite method steps corresponding to the apparatus features recited in claims 2, 3 and 5, Nehab et al. fails to either anticipate or render obvious claims 7, 8 and 9 for the same reasons that Nehab et al. fails to anticipate or render obvious corresponding claims 2, 3 and 5 as outlined above.

With respect to claim 10, which recites a method similar to method claim 9, Nehab et al. fails to anticipate or render obvious claim 9 for the essentially the same reasons that Nehab et al. fail to anticipate or render obvious similar claims 9, which also recites generating a card, a feature also not disclosed or suggested by Nehab, and for the reasons outlined above regarding claim 6, from which claim 9 depends, as outlined above.

For at least the reasons set forth above, Applicant respectfully submits that Nehab et al. fails to teach, disclose or suggest all of the features recited in claims 1-12. Thus, Nehab et al. fails to render obvious the subject matter of claims 1-12 under §103(a). Withdrawal of the rejection of claims 1-12 under 35 U.S.C. §103(a) as unpatentable over Nehab et al. is respectfully solicited.

The Office Action rejects claims 13 and 14 under 35 USC §103(a) as unpatentable over U.S. Patent 5,347,628 to Brewer et al. This rejection is respectfully traversed.

The Office Action alleges that an electronic office is a meta-level display wherein the calendar icon 23 is a goal outline, and the desktop icon 19 is a presentation outline, and the drawer icon 17 is where the data is stored.

Applicants respectfully disagree with this interpretation of Brewer et al. Brewer et al.'s calendar for planning is not disclosed as a goals outline which comprises organization of document information content and Brewer et al.'s desktop icon 19 is not disclosed as a presentation outline.

The only disclosure of a planning board as a goals outline and a desk mat as a display of a presentation outline is in Applicant's disclosure - see page 17, lines 15-25.

The Office Action is engaging in wholly impermissible hindsight reconstruction of Brewer et al. based solely on Applicant's disclosure.

As the Court stated in In re GPAC Inc., 35 USPQ2d 116 (Fed. Cir. 1995), "[W]e believe that this statement by the Board in support of its rejection of claim 2 is conclusory and lacks the factual basis required to validate a claim rejection under section 103. See, In re Warner , 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The Board] may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis."), cert. denied, 389 U.S. 1057 (1968).

Brewer et al. merely discloses a graphical user interface for accessing electronic data stored in a computer system. There is absolutely no disclosure of a method of authoring a document, or of a goals outline as recited or of a presentation outline as recited, or of linking a goals outline and a presentation outline as recited. The only basis for that disclosure is Applicant's disclosure. This rejection is a classic example of improper hindsight reconstruction of Applicant's invention based solely on Applicant's disclosure.

Also, the basis for modifying Brewer et al. is not a clear and definite teaching, as required by the case law cited above. The alleged basis of the motivation to modify Brewer et al. is that "the logical structure of the office image suggests the goal outline for creating such an image file and the layout of the office as seen in the figures suggests a presentation outline for an image file." This is not a clear and definite teaching. Rather it is perhaps the farthest stretch of imagination Applicants can conceive. It certainly was not apparent to Brewer et al. In fact, it only becomes apparent to one of ordinary skill in the art after reading Applicants' disclosure.

For at least the reasons outlined above, Applicant respectfully submits that Brewer et al. fails to teach, disclose or suggest all of the features of claims 13 and 14, and no proper motivation has been shown to radically modify Brewer et al. to provide the claimed invention totally missing from the Brewer et al. disclosure which is recited in claims 13 and 14. Thus, Brewer et al. fails to render obvious the subject matter of claims 13 and 14 under 35 U.S.C. §103(a). Withdrawal of the rejection of claim 13 under 35 U.S.C. §103(a) as unpatentable over Brewer et al. is respectfully solicited.

CONCLUSION

In view of the foregoing, reconsideration of the application is respectfully requested.

It is submitted that claims 1-14 define patentable subject matter. Allowance of 1-14 is respectfully requested.

Should the Examiner believe that there is anything further that is desirable to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Attachments:

Appendix
Terminal Disclaimer

Date: June 27, 2002

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<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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Changes to Claims:

APPENDIX

The following is a marked-up version of the amended claims:

1. (Amended) A document authoring device for a document which contains a goals outline and a presentation outline, comprising:

a user interface;

a memory;

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a controller coupled to the user interface and the memory, wherein the controller links the goals outline and the presentation outline of the document together based on an input received through the user interface and data stored in the memory to at least partially author the document, and further wherein the goals outline comprises organization of document information content ~~of the document~~ and the presentation outline comprises appearance characteristics of the document.

6. (Amended) A method of authoring a document which contains a document goals outline and a document presentation outline, comprising:

storing data in memory;

receiving an input through a user interface; and

linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises organization of document information content and the presentation outline comprises appearance characteristics.

10. (Amended) A method of authoring a document, comprising:

storing data in a memory;

receiving inputs through a user interface;

linking a goals outline comprising organization of document information
content to a presentation outline based on the inputs and the data;
receiving external information by the controller;
generating a card based on the external information; and
storing the card as data in the memory.

13. (Amended) A method of authoring a document, comprising:
storing data in a memory;
receiving inputs through a user interface;
linking a goals outline comprising organization of document information
content to a presentation outline based on the inputs and the data; and
displaying on the display device a meta-level display of the goals outline and
the presentation outline.